

REMARKS

The Examiner has rejected Claims 5-7 and 17-19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, with respect to Claim 5 et al., the Examiner has argued that such claim is “confusing” and has required further explanation as to who is specifically doing the steps involved. Applicant respectfully asserts that Claim 2 et al., from which Claim 5 et al. depends, clearly claims that “a site sends the information [that includes an Internet Protocol (IP) address of a user and an amount of payment due],” in the context claimed. Claim 5 et al., however, claims that “user data [is identified] based on the received information, and...the user data [is sent] to the site” (emphasis added), as claimed.

The Examiner has also rejected Claims 1, 2, 4, 5, 8, 11, 13, 14, 16, 17, 20, 23, 25, 27 and 28 under 35 U.S.C. 102(b) as being anticipated by Ronen et al. (U.S. Patent No. 5,905,736). In addition, the Examiner has rejected Claims 6, 9, 10, 18, 21, 22, 26, and 29 under 35 U.S.C. 103(a) as being unpatentable over Ronen, in view of Egendorf (U.S. Patent No. 5,794,221), and in further view of Official Notice. Applicant respectfully disagrees with such rejections, especially in view of the amendments made hereinabove to the independent claims. Specifically, applicant has amended at least some of the independent claims to substantially include the subject matter of former dependent Claims 2, 4-6, and 29 et al.

With respect to independent Claim 26, the Examiner has relied on Col. 1 and Col. 2 from Ronen to make a prior art showing of applicant’s claimed “providing a link to a site on a network where a business transaction is occurring.”

Applicant respectfully asserts that the excerpt from Ronen relied on by the Examiner simply teaches that “billing is centralized for information and/or services, or for any type of transaction conducted over the Internet by users connected through an Internet Access Provider (IAP) to one or more ISPs” (Col. 2, lines 5-8). However,

applicant respectfully notes nowhere in the excerpt relied on by the Examiner is there any suggestion of “providing a link to a site on a network,” and especially not where such “site...[is] where a business transaction is occurring” (emphasis added), as applicant claims.

In addition, with respect to independent Claim 26, the Examiner has relied on Col. 7, lines 37-40 and item 120-3 in Figure 1 of Ronen to make a prior art showing of applicant’s claimed “conditionally administering payment for the payment due by billing against the account in accordance with any identified rules.”

Applicant respectfully asserts that the item 120-3 in Figure 1 of Ronen merely shows a bank debit card. Further, the excerpt relied on by the Examiner simply discloses that the “billing mechanism will include the user’s desired method or methods of billing, and any parameters that define when a particular billing method is to be applied.” Clearly, parameters that define when a particular billing method is to be applied, as in Ronen, fails to meet applicant’s claimed “conditionally administering payment...in accordance with any identified rules” (emphasis added), as claimed.

Still with respect to independent Claim 26, the Examiner has relied on Col. 4, lines 1-6 in Egendorf to make a prior art showing of applicant’s claimed “identifying shipping information based on the received information.”

Applicant respectfully asserts that the excerpt from Egendorf relied on by the Examiner simply discloses that “the vendor may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer.” Clearly, simply verifying that an address supplied by a customer has been verified by the customer, as in Egendorf, fails to specifically teach “identifying shipping information based on the received information” (emphasis added), especially where such information is received “from the site [where the business transaction is occurring]” and includes “an Internet Protocol (IP) address of [the] user and an amount of payment due,” in the context claimed by applicant.

In fact, applicant emphasizes that Egendorf only teaches that “the vendor may verify with the provider...the address supplied by the customer” (emphasis added). Thus, in Egendorf, the address is expressly disclosed to be supplied by the customer, which does not meet applicant’s claimed “identifying shipping information based on the received information,” where the information is received “from the site [where the business transaction is occurring],” in the specific context claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has substantially incorporated the subject matter of former dependent Claims 2, 4-6, and 29 et al. into various independent claims.

With respect to former dependent Claim 6 et al. (at least substantially included in some of the independent claims), the Examiner has relied on Col. 4, lines 1-6 in Egendorf to make a prior art showing of applicant’s claimed technique “wherein the user data includes shipping information.”

As argued above with respect to independent Claim 26, applicant respectfully asserts that the excerpt from Egendorf relied on by the Examiner simply discloses that “the vendor may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer.” Clearly, simply verifying that an address supplied by a customer has been verified by the customer, as in Egendorf, fails to specifically teach that “the user data includes shipping information” (emphasis added), especially since such user data is identified “based on the received information” which includes “an Internet Protocol (IP) address of [the] user and an amount of payment due,” in the context as presently claimed by applicant.

In addition, with respect to former dependent Claim 29 (the subject matter of which has been at least substantially incorporated into each of the independent claims), the Examiner has relied on Cols. 3-5; Col. 4, line 67-Col. 5, line 10; and Col. 6, lines 13-35 in Egendorf, and has also taken Official Notice in rejecting applicant’s claimed technique “wherein a uniform resource locator (URL) link is provided to the user from the site, where the URL allows the user to give permission for the payment to be administered, and, in response to the user giving the permission, the site is provided with a confirmation number and the shipping information of the user and the user is provided with the confirmation number,” as currently claimed.

First, with respect to the Examiner’s rejection of applicant’s claimed technique “wherein a uniform resource locator (URL) link is provided to the user from the site, where the URL allows the user to give permission for the payment to be administered” under Official Notice, applicant notes that the Examiner has merely argued that “it is old and well known in the art of Internet e-commerce that URL is an address for a resource on the Internet” and that “[i]t would have been obvious to...modify Ronen and Egendorf to explicitly disclose a URL link in order to access a server that has payment instructions as is old and well known in order to provide the user with a quick method of payment.”

Applicant respectfully disagrees. For example, as admitted by the Examiner, Ronen fails disclose any sort of “allow[ing] the user to give permission for the payment

to be administered,” as applicant claims. Thus, it would not have been obvious to modify Ronen to provide “a uniform resource locator (URL) link... to the user from the site, where the URL allows the user to give permission for the payment to be administered” (emphasis added), as applicant claims.

In addition, applicant respectfully asserts that excerpts from Egendorf relied on by the Examiner to meet applicant’s claimed “allow[ing] the user to give permission for the payment to be administered,” simply disclose that the “[p]rovider 2 establishes an agreement with each of [the] customers 4.1-4.n,” that the “billing will be done to billing accounts established in connection with the agreements” (Col. 4, line 67-Col. 5, line 5), and that “whenever a transaction amount is to be billed, it will be billed to that specified billing account” (Col. 6, lines 23-24).

Clearly, Egendorf only discloses customer agreements which specify billing accounts to be billed, which does not even suggest “allow[ing] the user to give permission for the payment to be administered,” as applicant claims. Thus, it also would not have been obvious to modify Egendorf to provide “a uniform resource locator (URL) link... to the user from the site, where the URL allows the user to give permission for the payment to be administered” (emphasis added), as applicant claims.

Accordingly, in response to the Examiner’s rejection of applicant’s claim language under Official Notice, applicant again points out the remarks above that clearly show the manner in which the claimed subject matter further distinguishes the Egendorf and Ronen references. Applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

“If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

Still yet, Cols. 3-5 from Egendorf, as relied on by the Examiner to meet applicant’s claimed technique where “in response to the user giving the permission, the

site is provided with a confirmation number and the shipping information of the user and the user is provided with the confirmation number,” only generally disclose that “[d]epending on the type of goods, delivery can be made” (Col. 3, lines 11-12), that “the vendor may verify with the provider that the address supplied by the customer for shipment of the goods has been authorized by the customer” (Col. 4, lines 1-3-emphasis added), and that “[p]rovider 2 can then send verifying information to one or both of the customer and vendor to indicate that the transaction has been approved, if approval of a third party, such as [a] credit card company, is required” (Col. 5, lines 35-39-emphasis added).

Clearly, Egendorf only discloses the provider sending verifying information to the customer and vendor to indicate that the transaction has been approved, if approval of a third party is required, which simply does not even suggest that “in response to the user giving the permission, the site is provided with a confirmation number... and the user is provided with the confirmation number” (emphasis added), in the manner as claimed. Furthermore, Egendorf only generally discloses that the shipping address is supplied by the customer, but not specifically that “in response to the user giving the permission, the site is provided with... the shipping information of the user” (emphasis added), in the manner as claimed.

Thus, a notice of allowance or a proper prior art showing of all of applicant’s claim limitations, in combination with the remaining claim elements, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to dependent Claim 7 et al., as rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen, in view of Wilf et al. (U.S. Patent No. 5,899,980), the Examiner has relied on Col. 8, lines 12-41, Col. 9, lines 18-20 and Col. 3 from Wilf to make a prior art showing of applicant’s claimed “requesting permission from the user prior to sending the user data to the site.”

In particular, the Examiner has argued that “Wilf...teaches that the customer can either confirm or deny the transaction after inspecting the transaction details.” Applicant respectfully disagrees. Simply confirming or denying a transaction, as noted by the Examiner, fails to even suggest “requesting permission from the user prior to sending the user data to the site,” especially where such “user data includes shipping information” (emphasis added), in the context claimed by applicant (see respective independent claims for context).

In fact, applicant respectfully points out the transaction details in Wilf merely include “the price and serial number of the requested product or service and additional details such as the payment date or other payment terms” (Col. 7, lines 54-57). Clearly, allowing a customer to confirm or deny a transaction after inspecting such details, as in Wilf, does not meet applicant’s claimed “requesting permission from the user prior to sending the user data to the site,” where the such “user data includes shipping information” (emphasis added), in the specific context claimed.

Again, since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or a proper prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.

Still yet, applicant brings to the Examiner’s attention the subject matter of new Claim 30 below, which is added for full consideration:

“wherein the rule identifies at least one category in which goods or services are permitted to be purchased” (see Claim 30).

Again, a notice of allowance or a proper prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. AMDCP006).

Respectfully submitted,
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